

REMARKS/ARGUMENTS

The rejections presented in the Office action dated October 19, 2004 have been considered. Claims 12-14, 18 and 22-25 are currently pending in the application, where Claims 1-9 are subject to the restriction requirement maintained by the Examiner.

Regarding the election/restriction requirement, the Applicants maintain that the requirement for restriction is improper under M.P.E.P. § 806.05(e). The Examiner noted that the Applicant contended that the invention must be entirely practiced by hand to be subject to restriction. The Applicants argument was, more specifically, that M.P.E.P. § 806.05(e) requires that the process as claimed be capable of being carried out by hand. The Applicants contend that the “process as claimed” is not composed of a selected subset of the claim, and the Applicants maintain the position that the ability to carry out some selected subset of a claimed process does not meet the test set forth in M.P.E.P. § 806.05(e). The Applicants thus maintain that it has not been properly established that the *process as claimed* is capable of being carried out by hand. By way of this traversal, the Applicants reserve the right to petition the requirement for election/restriction.

Claims 10, 15 and 19-25 stand rejected under 35 U.S.C. §101 as lacking patentable utility. The Applicants respectfully traverse the rejection. The Applicants respectfully submit that a *prima facie* case establishing that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas, or does not produce a useful result, has not been shown. The Examiner carries the initial burden of establishing a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas, or does not produce a useful result. M.P.E.P. § 2106(II)(A). Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. *Id.* (emphasis added). The Applicants respectfully submit that this requirement has not been met, and consequently a lack of utility is not properly established.

In the Office Action, it is contended that Claims 10, 15 and 19-25 “only claim the manipulation of data....” A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See M.P.E.P. § 2106(II)(A); citing *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (emphasis added). It is respectfully submitted that the rejected claims do not consist solely of the manipulation of data as is contended in the

Office Action. Appropriate structural and/or functional limitations are recited to perform certain functions as it pertains to data, but this does not consist solely of the manipulation of data. The Applicants reserve the right to present claims and arguments to that end.

However, in order to facilitate prosecution of the application, the Applicants have amended the claims. Claims 10 and 15 have been canceled without prejudice or disclaimer. Thus, the §101 rejection is moot as it pertains to Claims 10 and 15. Claims 12 and 17 have been rewritten in independent form, including all of the limitations of their respective base claims and any intervening claims. Because Claims 12 and 17 have merely been rewritten in independent form, and not substantively changed in this regard, the Applicants have not intended to narrow Claims 12 and 17, nor have these claims been narrowed by changing their drafted format.

Claims 19-25 are also subject to the §101 rejection. Claims 19-21 have been canceled without prejudice or disclaimer. Thus, the §101 rejection is moot as it pertains to Claims 19-21. Claim 22 has been rewritten in independent form, including all of the limitations of its base claim and intervening claims. Because Claim 22 has merely been rewritten in independent form, and not substantively changed in this regard, the Applicants have not intended to narrow Claim 22, nor has Claim 22 been narrowed by changing their drafted format.

As to the §101 rejection of Claim 22, the Applicants respectfully traverse. Claim 22, rewritten in independent form, clearly provides a useful, concrete and tangible result in the reward that is formulated in response to comparison of the product code. Thus, the Applicants respectfully request that the utility rejection to Claim 22 be withdrawn.

Claim 23 has been amended to introduce the formulation of the reward based on at least the product code relative to other product codes available to the server. The reward clearly provides a useful, concrete and tangible result. Thus, the Applicants respectfully request that the utility rejection to Claim 23 be withdrawn. Claims 24 and 25 are dependent from Claim 23, and include the limitations of Claim 23, and therefore also provide a useful, concrete and tangible result. The §101 rejection to Claims 24 and 25 is also overcome, and withdrawal of the rejection is respectfully requested.

Claims 10-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicants have addressed these rejections as described below.

Claims 10, 11, 15-17 and 19-21 have been canceled, and the rejection is thus moot as it pertains to these claims. Claims 12, 18, 22 and 23 have been amended to address the rejection. For example, Claim 12 restates the language “for collecting data on a communication device user” to “for collecting data relating to a user of a communication device.” Similar language has now been used in Claims 18, 22 and 23. Claim 14 has been amended to address the antecedent basis issue. Claim 22, which has been rewritten to include the limitations of Claim 19, has been amended to clarify that the product referred to is the product which has a product code. As to the rejection of Claim 23 relating to the phrase “said user code” on line 4, it is assumed that the Examiner intended to reject Claim 24 rather than Claim 23, as it is Claim 24, line 4, which includes the quoted language. Claim 24 has been appropriately amended to address the antecedent basis issue, and the Applicants thank the Examiner for noting this. Based on these amendments and remarks, it is respectfully requested that these rejection under §112 ¶2 be withdrawn.

Claim 25 has also been rejected under 35 U.S.C. §112, ¶2, for the use of the term “Bluetooth.” The Examiner contends that where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with 35 U.S.C. §112, ¶2. The Applicants respectfully disagree with the Examiner’s characterization of the term “Bluetooth,” and respectfully submit that the term “Bluetooth” is a “name used in trade” as defined in the M.P.E.P., rather than a “trademark” as defined in the M.P.E.P. M.P.E.P. §608.01(v) distinguishes between a “trademark” and “names used in trade.” A trademark is a proprietary word, letter, symbol or device *adopted by one manufacturer or merchant* and used to identify and distinguish his or her product from those of others, and *points distinctly to the product of one producer.* (M.P.E.P. §608.01(v)). On the other hand, a “name used in trade” is a nonproprietary name by which an article or product is known and called among traders or workers in the art, and “names used in trade” do not point to the product of one producer, but identify a single article or product irrespective of producer. (M.P.E.P. §608.01(v)). Names used in trade are permissible in patent applications if their meanings are established by an accompanying definition sufficiently precise to be made part of a claim, OR the meaning is well-known and satisfactorily defined in the literature in this country. It is respectfully submitted that the term “Bluetooth” is a “name used in trade” that is very well-known in this country and well-

defined in the literature. For at least this reason, the Applicants respectfully request withdrawal of the 35 U.S.C. §112, ¶2 rejection to Claim 25.

Claims 10-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jelen et al.* (U.S. Patent No. 6,129,276) in view of *Ruppert et al.* (U.S. Patent No. 5,640,002) and Examiner's Official Notice. The Applicants respectfully traverse based on the amendments and remarks provided herein.

Claims 10, 11, 15-17 and 19-21 have been canceled, and the rejection is thus moot with respect to these claims. However, it is respectfully submitted that Claims 12, 18, 22 and 23 are not rendered obvious by the combination of *Jelen* and *Ruppert*. To establish a *prima facie* case of obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

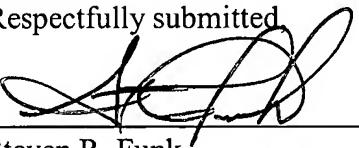
No specific portions of *Jelen* and *Ruppert* have been cited as teaching any reward function or component for formulating a reward. From a review of these references, the Applicants respectfully submit that neither *Jelen* nor *Ruppert* teach or suggest, either alone or in combination, any function or component for formulating a reward. While the Applicant does not acquiesce that other elements are taught by the combination of *Jelen* and *Ruppert*, the Applicants submit that at least the reward function/components is not taught. Because the prior art references must teach or suggest all of the claim limitations, and because the combination fails to do so, it is respectfully submitted that *prima facie* obviousness has not been established for Claims 12, 18, 22 and 23. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103 is respectfully solicited.

Dependent Claims 13 and 14 are dependent from independent Claim 12, and dependent Claims 24 and 25 are dependent from independent Claim 23. Claims 13, 14, 24 and 25 were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Jelen* and *Ruppert*. While the Applicants does not acquiesce with any particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made

in connection with independent Claims 12 and 23. These dependent claims include all of the limitations of their respective base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 13, 14, 24 and 25 are also allowable over the combination of *Jelen* and *Ruppert*.

Reconsideration of the pending claims and allowance of the application in view of the present amendment and response is respectfully requested. If the Examiner believes it to be helpful, the undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

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Respectfully submitted
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